



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/178,594	10/26/98	ISHIGURO	U-WP-5103B-K

MILTON J WAYNE
BURGESS RYAN AND WAYNE
370 LEXINGTON AVENUE
NEW YORK NY 10017

HM22/0112

EXAMINER

BERCH, M

ART UNIT

PAPER NUMBER

1611

DATE MAILED: 01/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/178,594

Applicant(s)
Ishiguro

Examiner
Mark L. Berch

Group Art Unit
1611



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 and 15-19 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 and 15-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1611

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, and 15-19 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and/or failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Specifically:

1. The substituent list for R_3 appears twice: on page 6, in the first and second full paragraphs. These have some similarities and some differences. For example, both have lower alkyl. The first has halogen but not carboxyl; the second has just the reverse. (paragraph 2)
2. Further, the list lacks description. For example, the first R_3 choice is trisubstituted silyl. The first substituent listed is halo, giving e.g. Cl_3Si . Where is such a group set forth? The terms after acyl in the second list: Where did they come from? (paragraph 1)

Art Unit: 1611

3. There is a lack of description for the terms for X and Y come from that have been inserted at page 6, line 1, starting from carboxyl to line 5 with "Groups,". For example, there has been added a "carboxyl" and a "thiocarboxyl" groups, which lack any description. Applicants must show where these terms came from. (paragraph 1)
4. This is also true for the substituents for the X and Y groups added, starting from the "carboxyl" at the fifth from last line through the end of the claim. Where did these terms come from? It should also be noted that while "thioester" was removed, that would be normally understood as something like AC(S)OB, but terms added like aralkylthiocarbonyl would be of the form AC(O)Saralkyl, i.e. is a thiolester, not a thioester. Moreover, where did the e.g. "aralkyl" come from? (paragraph 1)
5. A major part of the X and Y definition is missing. The arylthio through heterocyclicoxy material present in the parent's claim 17 language is gone. This presumably does not represent applicants' intention, although there is nothing specifically indefinite about such a removal. (paragraph 2)
6. The term "salts of Copper with organic carboxylic acids" is broader than then specification, which says, "salts of Copper with aliphatic carboxylic acids" and "salts of Copper with aromatic carboxylic acids". The specification is thus narrower, not permitting salts of e.g. cyclohexanecarboxylic acid or piperidinecarboxylic acid, which is now permitted by the claims. The traverse in the parent was not persuasive. The problem is not with enablement, or where the "novelty of the invention" resides. The problem is one of description. The current language is a little broader than what the

Art Unit: 1611

specification says. The fact that someone could figure out what other compounds of copper (or any other metal for that matter) would work is not the point, as the problem is a lack of description, not enablement. (paragraph 1)

7. Choice (b), the mixture of zinc with anything in (a) is beyond what the specification says. A single example of zinc with one particular Copper complex does not constitute a description of zinc with all of (a). The traverse in the parent was not persuasive. The examiner is not saying that this or that won't work, only that the claim language goes beyond what the specification says. There simply isn't a description of zinc plus anything in (a). If the specification does not describe it, the claims can't claim it, even if it would indeed work just fine. (paragraph 1)

8. "General" is indefinite. A formula cannot be both general and specific. Deletion from Claims 1 and 18 is suggested. (paragraph 2)

9. The scope of "metal base" in claim 16 is not enabled. This would cover things like sodium bicarbonate, weak bases which cannot provide for an enolate. (paragraph 1)

10. Claim 16 is improperly dependent. It sets forth a step which is not provided for in Claim 15, which makes no provision for this. It is suggested that Claim 16 have the conventional "further comprising the step of..." language, which will make it properly dependent. (paragraph 2)

11. In claim 1, "substituted" and "esterified" with what? What is the scope of the zinc and cu compounds? Would this include Zn alloys and Cu based dyes? Page 44, line 16

Art Unit: 1611

should be "taken together with the carbon to which they are attached to form..."

Claim 1 should be cancelled.

Specification

In the parentage, "based on" is imprecise. Suggested is "which is a 371 of".

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

A handwritten signature in black ink, appearing to read "Mark L. Berch". The signature is fluid and cursive, with the first name "Mark" being more prominent than the last name "Berch".

Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

January 7, 1999